



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Application Branch

In re Patent Application of

Applicant : Yoshimi HIRAHARA )  
Serial No. : 09/726,451 )  
Filed : December 1, 2000 )  
For : RADIO COMMUNICATION )  
SYSTEM )  
Attorney Docket: 32014-167949 )

PETITION BY ASSIGNEE  
UNDER 35 USC 118 AND  
37 CFR 1.47(b)

RECEIVED  
MAY 22 2001  
OFFICE OF PETITIONS

March 2, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This Petition is being submitted under the provisions of 35 USC 118 and 37 CFR 1.47(b) to allow the Applicant, Oki Electric Industry Co., Ltd. (hereinafter Oki), to complete filing of the above-identified application on behalf of and agent for the inventor, Mr. Yoshimi HIRAHARA, who cannot be found or reached after diligent effort.

The basis for this Petition is as follows:

1. A Declaration of Facts prepared by Miho Kunie, a member of the Patent Department, Legal & Intellectual Property Division, of Oki is enclosed.
2. An Inventor's Declaration in conformance with 37 CFR 1.63 and 1.64, executed by Mr. Tomoo ARAKI, General Manager of the Legal & Intellectual Property Division of Oki on February 13, 2001, is also enclosed. The address given for Mr. Hirahara in the Declaration is the last known address of Mr. Hirahara.

03/05/2001 SSB/E1 00000150 09726451

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04 FD:122

3. Mr. Hirahara joined Oki on April 1, 1991, at which time he agreed in writing to assign his future inventions and patent applications to Oki. Further, Mr. Hirahara completed an Invention Report dated September 24, 1999 in which he identified his invention as a RADIO COMMUNICATION SYSTEM and stated "Assignment: The invention relating to RADIO COMMUNICATION SYSTEM is assigned to Oki Electric Industry Co., Ltd." A copy of the Invention Report and a concise translation into English is also enclosed. Thus, it is submitted that Applicant has made out a *prima facie* case that the invention has been assigned to Oki by Mr. Hirahara.

4. The filing of this application is necessary to preserve the rights of the parties and to prevent irreparable damage thereto. Concurrent with the filing of this application on December 1, 2000, a claim for priority under 35 USC 119 was made based on application No. 344,162/1999 filed in Japan on December 3, 1999. Following filing of the Japanese application, a diligent effort was made to file the U.S. application within the priority year.

Specifically, it was necessary to convert the Japanese '162 application into an application acceptable to the U. S. Patent and Trademark Office by translating the Japanese application into the English language, supplementing the disclosure of the Japanese application to assure compliance with the provisions of the first paragraph of 35 USC 112, drafting claims which would comply with the second paragraph of Section 112 and making other changes to assure compliance with U.S. statutes and rules. Taking into account a heavy volume of patent applications to be prepared for filing in the United States, the period of time between the filing of the priority application on December 3, 1999 and the forwarding of the application to the inventor on September 14, 2000 (See

accompanying Declaration of Facts) was not unreasonable and is evidence that the present Applicant acted with diligence..

5. The Petition fee of \$130 set forth in 37 CFR 1.17(h) is enclosed. If this fee is not sufficient, please charge Deposit Account 22-0261 and notify the undersigned.

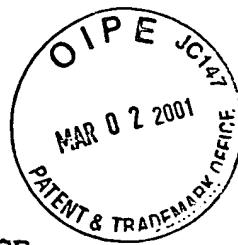
Respectfully submitted,

*Robert J. Frank*

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DECLARATION OF  
FACTS

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

I, Miho Kunit, a member of the patent Department, Legal & Intellectual Property Division, of Oki Electric Industry Co., Ltd. (hereinafter Oki) hereby declare that I have firsthand knowledge of the facts relating to efforts made to find or reach Mr. Yoshimi Hirahara for the purpose of having him execute the Inventor's Declaration and Assignment to Oki of the above-identified patent application. These facts are as follows:

1. Mr. Hirahara was employed by Oki on April 1, 1991. At that time, he signed a paper agreeing to assign his future inventions and patent applications to Oki.
2. On September 24, 1999, Mr. Hirahara submitted an Invention Report relating to an invention titled RADIO COMMUNICATION SYSTEM. The Report stated "Assignment: The invention relating to RADIO COMMUNICATION SYSTEM is

assigned to Oki Electric Industry Co., Ltd." A copy of the Invention Report and a concise translation thereof into the English language are enclosed.

3. On December 3, 1999, patent application 344162/1999 disclosing the Radio Communication System invented by Mr. Hirahara was filed in the Japanese Patent Office.

4. On April 12, 2000, Mr. Hirahara resigned from his employment at Oki.

5. Attempts were made thereafter to reach Mr. Hirahara at his last known address, 1-4-16-202 okubo, narashino-shi, Chiba 275-0011, Japan. A telephone call to this address was answered by another person, who said he had no relation to Mr. Hirahara and did not know where he is presently located. We contacted other persons, including Mr. Hirahara's coworkers, but none were able to advise his present whereabouts.

6. On September 14, 2000, I wrote to Mr. Hiraihara at his last known address advising him that Oki had decided to file the above-identified patent application in the USPTO. A copy of the application together with a Declaration and Assignment were sent with the letter and he was asked to affix his signature to these documents and return them our office by September 25, 2000 so that they could be filed before the priority due date. No response was received to this letter. A copy of this letter and an English translation thereof are enclosed.

7. We have not heard further from Mr. Hirahara and have thus far been unable to determine where he is living or to contact him.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the

like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

February 27, 2001  
Date

  
\_\_\_\_\_  
Miho Kurnie, Patent Department  
Legal & Intellectual Property Division

2000年 9月 14日

平原 可巳 様

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法務・知的財産部

特許担当:国江

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### 発明者サインのお願い

弊社整理番号: F-99EC0111-US-EC(425)

貴殿ご発明「移動通信システム」(特願平11-344162号)につきまして、この度米国へ特許出願されることになりました。

お忙しい所申し訳ございませんが、下記に従いまして添付書類へサインしてくださいますようお願い申し上げます。

また、米国特許庁への提出期限がございますので、サイン後の書類につきましては2000年9月25日(月)までに担当:国江までご返送願います。

#### 記

- サインして頂く書類は Declaration および Assignment の2種類です。それぞれサイン個所には付箋が張ってあります。
- 記載方法は添付の「原稿チェック/英文サインのお願い」を参考にしてください。

添付書類: Declaration/Assignment

各1部

原稿チェック/英文サインのお願い

1部

出願英文明細書

1部

以上

BEST AVAILABLE COPY

September 14



Mr. Yoshimi HIRAHARA

Miho KUNIE

Oki Electric Industry Co., Ltd.  
Legal & Intellectual Property Division  
10-3, Shibaura, 4-chome, Minato-ku,  
Tokyo 108-8551  
TEL:03-3455-3039 FAX:03-3798-7246  
Email: kunie673@oki.co.jp

**RE: Request for SIGNATURE**

OUR REF. : F-99EC0111-US-EC(425)

We are pleased to inform you that we have decided to file your invention having Japanese serial number P2000-344162, RADIO COMMUNICATION SYSTEM, to the USPTO.

Kindly, sign your signature on enclosed documents according to the following notice.

Also, please send the documents back to our office by September 25, 2000 in order to file them before the priority due date.

**NOTICE**

- Both a Declaration and an Assignment have to be signed.
- Refer to an enclosed Instruction of signing.

Encl.

- Declaration/Assignment
- Instruction of signing
- Specification and Drawings

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## Invention report



# OKI 發明・意匠届出書

知財部門政策

知 財 部 記 門 統 管	受付No. 99EC-111 事務所No.	・ ・ ・ ・
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### 発明・創作（以下発明という）登記費

1999 年 9 月 24 日

\* 1

\* 2

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[Concise Translation of the Invention Report]

\*1 Title: RADIO COMMUNICATION SYSTEM

\*2 Assignment: The invention relating to RADIO COMMUNICATION SYSTEM is assigned to Oki Electric Industry Co., Ltd.

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